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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/486,823	03/03/2000	JUNICHI SHIMADA	506.38266X00	3013

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ANTONELLI TERRY STOUT AND KRAUS  
SUITE 1800  
1300 NORTH SEVENTEENTH STREET  
ARLINGTON, VA 22209

EXAMINER

SPIVACK, PHYLLIS G

ART UNIT PAPER NUMBER

1614

DATE MAILED: 05/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
**09/486,823**

Applicant(s)  
**Shimada et al.**

Examiner  
**Phyllis Spivack**

Art Unit  
**1614**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Feb 26, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 6-17 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-17 is/are allowed.
- 6) ☒ Claim(s) 6-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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Applicants' Amendment filed February 26, 2002, Paper No. 14, is acknowledged. Claims 6-17 remain under consideration.

In the last office Action all claims were rejected under 35 U.S.C. 112, first paragraph, for lacking enablement for compounds of formula I wherein any heterocyclic group was possible for the R<sub>5</sub> group. Following an amendment to claims 6, 10 and 14 wherein the heterocyclic moieties contemplated as substituents on formula I are limited to furyl, pyridyl or methylenedioxy, this rejection of record is withdrawn.

Claims 6, 7, 10, 11, 14 and 15 were rejected in the last Office Action under 35 U.S.C. 102 (b) as being anticipated by Kuefner-Muehl et al., DE 3843117. It was asserted Kuefner-Muehl teaches the administration of xanthines as adenosine receptor antagonists to treat aging-related illnesses such as the neurodegeneration seen in Alzheimer's disease.

Applicants argue cycloalkyl is no longer an option for instant group R<sub>4</sub> in instant formula I. Further, Applicants urge a compound of formula I having R<sub>4</sub> defined as the specific groups in amended claims 6, 10 and 14 is neither disclosed nor suggested by Kuefner-Muehl.

Applicants' arguments have been carefully considered and are persuasive. This rejection of record under 35 U.S.C. 102(b) is withdrawn.

Claims 6-17 were rejected in the last Office Action under 35 U.S.C. 102(a) as being anticipated by Miwa et al, JP 09040652 (abstract). It was asserted Miwa teaches compounds of instant formula I in the treatment of degenerative disorders.

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Applicants argue the reference provides only that the recited derivatives are useful as intermediates for producing drugs having use in the treatment of degenerative disorders.

This rejection of record under 35 U.S.C. 102(a) is withdrawn because the disclosed compounds are useful only as intermediates in the production of therapeutic drugs.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al., U.S. Patent No. 5,484,920.

Suzuki teaches compounds of instant formula I for use in the treatment of Parkinson's disease. Parkinson's disease is a degenerative disease of the nervous system.

Claims 10-17 are free of the prior art.

**THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Phyllis Spivack at telephone number 308-4703.

May 7, 2002

*Phyllis Spivack*

PHYLLIS SPIVACK  
PRIMARY EXAMINER